

**REMARKS**

Claims 1-7 and 11-14 are currently pending in the application. Applicant has amended claims 1, 11, 12, 13, and 14. Applicants request reconsideration of the application in light of the following remarks.

**Generally**

It appears that Glenn cannot be properly combined with Wood to meet the claims. (Note that Examiner Edouard previously relied upon Glenn, which rejection was overcome by adding language regarding a “human translator”.) Glenn is an electronic device which enables a user to select from words or sentences to obtain a translation. The recording and replaying aspect of Glenn is for the purpose of enabling the user to listen and compare his/her pronunciation to the retrieved translations, as set forth in column 2, lines 44-49. Thus, there is no translation implemented with regard to the recording and playing back of the user’s attempted pronunciations. Glenn is basically an electronic translation device for learning a language. Therefore, Glenn teaches away from a method performed by a human translator.

The patent to Wood is a system for facilitating simultaneous translation in a doctor’s office setting, and has no mention of recording, tapes, or even memory. Therefore, Wood is incapable of enabling the important steps of recording a phrase in a source language and simultaneously interpreting and translating the phrase into a target language while playing the phrase back for a sequential (or consecutive) delivery of the translation. In short, Wood does not enable a human translator to deliver a more precise consecutive interpretation and translation, as does the present invention. Furthermore, Glenn does not remedy the lackings of Wood, and Wood does not remedy the lackings of Glenn.

Applicant also asserts that the present claims are also patentable over the U.S. Patent No. 5,884,256 to Bennett et al. since ways to overcome Bennett were discussed in an interview with Examiner Edouard more than a year ago and have been implemented. For example, instantaneous playback, (now recited in the claims), is contrary to the disclosure of

Bennett; consecutive delivery enabled by simultaneous interpretation/translation during playback is not shown or described by Bennett; and utilizing a digital recording device that has a receiver or transmitter is not taught or suggested by Bennett. These aspects are now claimed in each of the independent claims. By way of additional evidence that Bennett does not anticipate or make obvious the present invention, a declaration under 37 C.F.R. 1.132 by a stenographer, Deborah Worsley, is included herewith in Exhibit A. In the declaration, Deborah Worsley makes it clear that the system of Bennett is not well adapted for use by a human translator in a court setting, and that attempting to do so by a human translator would not be obvious.

#### **Telephone Interview**

Applicant's attorney wishes to thank the Examiners for their courtesy and time during a telephone interview that was held on August 30, 2005. The Examiners' comments and insight were very helpful in preparing this response. It is hoped that the comments below reflect the spirit of the interview. In a follow up interview with Examiner Qi Han, the Examiner suggested including recitation defining the receivers as "wireless" and regarding the application of the method in a court of law or "courtroom". The term "courtroom" has been added to the independent claims 1, 11, and 12, the term "wireless" modifying "receiver(s)" has been added to claims 1 and 12, and claim 11 already had an analogous term. Thus, these terms are considered to further define these claims over the prior art.

#### **Rejections under 35 U.S.C. §112**

Claims 12-14 stand rejected by the Examiner under 35 U.S.C. 112. In accordance with this rejection, the claims have been amended to comply with the MPEP and a board decision permitting combination of aspects of the invention when presented in a particular way as set forth below. Thus, the claims are now believed to conform with Section 112. Applicants respectfully request that the rejection of claims 12-14 under 35 U.S.C. § 112 be withdrawn.

Claims 12-14 were rejected based on recitation of structural elements as well as method steps. Applicant points out that claims 1-7 and 11 have several structural elements as well, which were not rejected under 112 (2<sup>nd</sup>). We submit that including structural elements in method claims is appropriate as long as it is clear that the claims are directed to the method. (See MPEP 2173.05(p) which states: “There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention.”) Specifically, the board held that a step of “utilizing” that refers to a structural element in a method claim was not indefinite, as set forth in MPEP 2173.05(q).

Accordingly claims 12-14 have been amended to incorporate the term “utilizing” when referring to structural details. The term “utilizing” has also been incorporated in claims 1-7 and 11 for consistency and definiteness.

### **Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants’ disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

### **Claims**

Claims 1-2, 4-6 and 11-13 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Wood (U.S. Patent No. 5,426,706, hereinafter “Wood”), in view of Glenn et al. (U.S. Patent No. 6,098,034, hereinafter “Glenn”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claim 1 has been amended to include the limitations of at least one transmitter and a digital recording device having a receiver and utilizing the transmitter and receiver to receive and record the words in the source language in the digital recording device. Wood has simultaneous interpretation in a doctor/patient setting. There is no disclosure in Wood that relates to recording and playing back. There is no consecutive delivery. There is no need for consecutive delivery. In fact, the flow described in Wood, column 3, line 60 forward, teaches away from consecutive delivery. Glenn does not remedy the deficiencies of Wood. Glenn has a recording device that has nothing to do with translation by a human translator. In fact, the recording device of Glenn is for the purpose of evaluating one's own pronunciation when emulating a pre-recorded translation while learning a foreign language. Furthermore, the pre-recorded translations are analogue translations to be played on a loudspeaker, as set forth in column 2, lines 40-41. Thus, there is no teaching of transmitting, receiving, or recording words in a source language, and consecutively delivering a translation in a target language as now required by claim 1.

Bennett as applied earlier in the prosecution, and as addressed in the interview of August 30, 2005, does not anticipate or make obvious the invention of claim 1 because Bennett is directed to a stenography system, which does not deal with translation. Rather Bennett uses phonemes to transcribe sounds in the speech of a speaker, such that the transcription is not from one language to another as required for translation. Bennett discloses a recording device, which can be used to play back a spoken record for the purpose perfecting the record after the court proceeding. The system of Bennett is not designed for instant playback as required for the present invention, as claimed in claim 1. Rather, Bennett's system may incorporate flags for searching the audio recording for certain portions thereof. This tends away from instantaneous playback. In fact, an attempt to use the system of Bennett for such instantaneous playback would result in unacceptable delays in a court proceeding. (See the declaration by stenographer Deborah Worsley included herewith as Exhibit A.) Furthermore, Bennett has no teaching of simultaneous translation, consecutive delivery, a digital recording device having a receiver.

Rather, it appears that any recording made by Bennett's system would be recorded as they are spoken into a microphone of a common tape recorder 351 (Figure 9) or 553 (Figure

12). Bennett discusses applying search labels to an audio or visual record to aid in searching for and playing back a recorded question/answer in column 25, line 37 through column 6, line 33. However, use of the system by a human translator to implement the method of the present invention would not be obvious as set forth in the declaration by Deborah Worsley in Exhibit A. Claim 1 now recites instantaneous playback, which defines over the searching required before playback in the teachings of Bennett. Still further, it should be pointed out that claim 1 is directed to a method implemented by a human translator that is far removed from the steps of transcription and machine translation taught by Bennett. To reiterate, Bennett does not have simultaneous translation or consecutive delivery utilizing a digital recording device having a receiver.

Regarding claim 11, many of the arguments against Wood, Glenn and Bennett apply equally well because claim 11 recites many of the same limitations as does claim 1. For example, claim 11 recites simultaneous translation and consecutive delivery in real time. These features are not provided by Wood, Glenn, or Bennett. Claim 11 also recites utilizing the digital recording device of the present invention, in which the digital recording device has a transmitter. None of the references to Wood, Glenn, or Bennett have a transmitter in the recording device. Claim 11 also recites depressing first and second record activators and transmitting to at least two receivers, which is clearly unique to the present invention. Furthermore, the advantage of receiving and recording from more than one remote position and transmitting to more than one remote receiver station is clearly unique to the present invention and not merely a matter of design choice.

Claim 12 overcomes the rejections based on Wood, Glenn, and Bennett in a manner similar to claims 1 and 11 as described above. For example, claim 12 recites simultaneous translation and consecutive delivery in real time. These features are not provided by Wood, Glenn, or Bennett. Claim 12 also recites utilizing the digital recording device of the present invention, in which the digital recording device has a receiver similar to claim 1, a recording activator, a playback activator, and a plurality of transmitters operatively connected to the digital recording device. None of the references to Wood, Glenn, or Bennett have a receiver in the recording device or the other combination of features recited in claim 12. Claim 12 also recites activating the record activator. This, in combination with the method steps of

translating the spoken message while it is being played back and “verbally delivering a resulting consecutive translation relative to the step of recording the spoken message” are clearly distinct from the teachings or suggestions of Wood, Glenn, and Bennett.

Claims 2, 4-6, and 13 are considered to be patentable as depending from allowable base claims 1, 11, and 12 for reasons set forth above and for additional patentable features as may be appreciated by the Examiner.

Claims 3 and 14 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Wood and Glenn as applied to claims 1 and 12 above, and further in view of Cherny (U.S. Patent No. 6,219,646, hereinafter “Cherny”). Applicants respectfully traverse this rejection and request reconsideration of the claims. The invention of Cherny is directed to achieving “a near real time” conversation between two people having a conversation and utilizes subject matter databases. Thus, Cherny teaches away from translation by a human translator and away from consecutive delivery of a simultaneous translation made during playback. Cherny discloses translation in relation to telephony transmission, but fails to remedy the lackings of the base claims to Wood and Glenn. Furthermore, the telephone system of Cherny does not appear to be connected to a digital recording device having a transmitter or receiver in the digital recording device, as is utilized in the present invention.

Claim 7 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Wood and Glenn as applied to claim 1 above, and further in view of well known prior art (MPEP 2144.03). Applicants respectfully traverse this rejection and request reconsideration of the claims. Claim 7 is considered to be patentable as depending from allowable base claim 1 and for additional patentable features as may be appreciated by the Examiner.

Applicants respectfully request that the obviousness rejections of claims 1-7 and 11-14 be withdrawn.

**Regarding Doctrine of Equivalents**

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.


**CONCLUSION**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The amendments herein added no new claims, resulting in no fees due for additional claims. It is requested that a two-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$225.00 is enclosed herewith.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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